

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP Appeal Brief – Patents
)	
Stefan ANDERSSON)	Group Art Unit: 2137
)	
Application No.: 09/977,192)	Examiner: WILLIAMS, Jeffery L.
)	
Filed: October 16, 2001)	Confirmation No.: 3198
)	
For: SECURITY SYSTEM)	

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a response to the Notification of Non-Compliant Appeal Brief purportedly mailed by the Office on December 26, 2007. A Petition for Five-Month Extension of Time and corresponding required fee are concurrently herewith. However, Applicant intends to file a request for refund of the fee because the Notification of Non-Compliant Appeal Brief was never received by Applicant. Applicant first became aware of the Notification of Non-Compliant Appeal Brief as a result of a courtesy call made on June 20, 2007 (i.e., already into the fifth-month extension period) by Examiner Williams inquiring whether a Response to the Notice had already been filed. This response is prepared based on a copy of the Notification that was obtained from Private PAIR on June 20, 2007.

Applicant's Remarks begin on page 2 of this paper.

An Amended Appeal Brief is being filed concurrently herewith.

REMARKS

The Notification of Non-Compliant Appeal Brief alleges that the Appeal Brief filed on November 24, 2006 is Non-Compliant because of two defects described as follows:

“8. The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).

9. The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).

10. Other (including any explanation in support of the above items):

The brief is missing headings Evidence Appendix and Related Proceedings Appendix, if there are none an indication “None” or “Not Applicable” is required”

Applicant respectfully traverses the allegation that the Appeal Brief filed on November 24, 2006 is non-compliant. 37 CFR 41.37(c)(1)(ix) states, in relevant part, “An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. ...” Applicant is not relying on any such evidence, and therefore has no copies to include in the appendix. Nothing in the regulation indicates that that an empty section must be included in the Brief if there are no “copies” to include. Even if one turns to the M.P.E.P for guidance on the Office’s internal policy concerning this issue, at most M.P.E.P. §1205.02, page 1200-15 (Rev. 3, August 2005) states “If there is no evidence being relied upon by appellant in the appeal, then an evidence appendix should be included with the indication ‘none.’” (Emphasis added.) It is well known that the word “should” is permissive, and does not require that a thing be done or included. (Compare with the word “must”, which indicates that something is mandatory.) Thus, the Appeal Brief is

not *per se* non-compliant for failing to include an Evidence Appendix when there is no evidence to submit.

Similarly, 37 CFR 41.37(c)(1)(x), in its totality, states “An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.” In this instance, there are no court or Board proceedings identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37. Therefore, Applicant has no copies to include in this appendix. Nothing in the regulation indicates that that an empty section must be included in the Brief. Even if one turns to the M.P.E.P for guidance on the Office’s internal policy concerning this issue, at most M.P.E.P. §1205.02, page 1200-15 (Rev. 3, August 2005) states “If there are no such copies of decisions being submitted in the appeal, then a related proceedings appendix should be included with the indication ‘none.’” (Emphasis added.) Since the word “should” is permissive (i.e., it does not require that a thing be done or included), the Appeal Brief is not *per se* non-compliant for failing to include a Related Proceedings Appendix when there are no related proceedings documents to submit.

Regardless of whether the Office agrees with Applicant’s interpretation of the word “should”, attention is directed to M.P.E.P. §1205.03, pages 1200-16 through 1200-17 (“Non-compliant Appeal Brief and Amended Brief”) which states:

The examiner should not require a corrected brief for minor non-compliance in an appeal brief (e.g., the brief has a minor error in the title of a section heading). The following are a few other examples where the examiner may accept a brief that has minor non-compliance:

(A) If the evidence appendix and related proceedings appendix are missing, but the record is clear that there is no evidence submitted and no related proceedings listed in the related appeals and interferences section, the examiner may accept the brief and state in the examiner’s answer that it is assumed that the appellant meant to include both appendixes with a statement of “NONE.”

(Emphasis added.)

Thus, in the present instance, the Examiner should have accepted the already-filed brief without requiring any “correction.”

Notwithstanding the above arguments, in order to expedite favorable prosecution of the application, filed concurrently herewith is an amended copy of the Appeal Brief with new appendix sections IX and X added to show where copies of evidence and court decisions would have been placed had there been any.

In view of the above, it is respectfully requested that the amended Appeal Brief be accepted, and the Appeal be allowed to continue. If the Office has any remaining questions or concerns about the Appeal Brief, it is requested that a call be placed to the undersigned attorney at 703.718.8884 to expedite resolution of any such issues.

Respectfully submitted,

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Date: June 25, 2007

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